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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/443,505 11/19/99 AUDOUSSET

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EXAMINER

LIOTT, C

ART UNIT	PAPER NUMBER
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1751

DATE MAILED:

12/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/443,505	Applicant Audousset
	Examiner Caroline D. Liott	Group Art Unit 1751

Responsive to communication(s) filed on Oct 19, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-18 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

• All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Applicant's Amendments filed 10/19/00 have been entered. Applicant's Remarks filed 10/19/00 have been fully considered.

Claim Rejections

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim, U.S. Patent No. 5,980,584, in view of Akram U.S. Patent No. 5,230,710. This rejection is maintained for the reasons set forth in the previous Office Action, Paper #7 mailed 10/19/00.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim '438 in view of Akram. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper #7 mailed 10/19/00.

Lim, U.S. Patent No. 6,074,438, teaches and exemplifies compositions for dyeing hair which contain the oxidation base 2-chloro-4-aminophenol in the claimed amounts and a pyrazolone coupler, see Abstract and Table 1, Composition C. The exemplified composition is mixed with a hydrogen peroxide oxidant as is applied to hair as claimed, see col. 10, line 65-col. 11, line 2. Lim teaches that additional couplers may be added to the compositions in order to obtain certain color nuances and tints, including the claimed 2,6-bis(hydroxyethylamino)toluene, as well as direct dyes and additional p-aminophenol oxidation bases as claimed, see col. 5, lines 1-

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11 and 32-37, and col. 6, line 24. Lim teaches that the compositions may be packaged in kits as claimed, see col. 10, lines 46-54. Lim does not exemplify a composition, process or kit as claimed, particularly which contains or uses the claimed coupler.

Akram is relied upon above as teaching that the claimed 2,6-bis(hydroxyethylamino)toluene has many improved properties when used as a coupler in hair dyeing compositions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a composition for dyeing hair which contains an oxidation base and coupler as claimed, as well as the claimed additional couplers and direct dyes, wherein each component is present in the claimed amounts, is packaged in kits as claimed, and is applied to hair in dyeing processes as claimed, because such compositions, processes and kits fall within the scope of those as taught by Lim. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed 2,6-bis(hydroxyethylamino)toluene for use as the additional coupler in Lim's compositions because Lim teaches the claimed coupler as being suitable for use in the patentee's compositions, and because Akram teaches that the claimed 2,6-bis(hydroxyethylamino)toluene is preferred and results in various improved dyeing properties such as intense colors and resistance to various agents. Therefore, based upon Akram's teachings, those skilled in the art would have been motivated to select the claimed coupler from among those taught by Lim for use in Lim's compositions, absent a showing otherwise.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 09/443,142. This provisional rejection is maintained for the reasons set forth in the previous Office Action, Paper #7 mailed 10/19/00. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application recite keratin fiber dyeing compositions which contain at least one oxidation base and the claimed 1,3-bis(β-hydroxyethyl) amino-2-methyl benzene coupler, wherein the oxidation bases and couplers may be present in the claimed amounts, see e.g. copending claim 1. The compositions may be used in keratin fiber dyeing processes as claimed, and may be packaged in multi-compartment kits as instantly claimed, see e.g. copending claims 26 and 31. The oxidation bases in the copending application may be p-aminophenol oxidation bases as claimed, see copending claims 11-12. The instantly claimed compositions, processes and kits are therefore obvious over the claims of the copending application, absent a showing otherwise.

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Similarly, claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 09/443,506. This provisional rejection is maintained for the reasons set forth in the previous Office Action, Paper #7 mailed 10/19/00. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application recite keratin fiber dyeing compositions which contain at least one oxidation base and the claimed 1,3-bis(β-hydroxyethyl) amino-2-methyl benzene coupler, wherein the oxidation bases and couplers may be present in the claimed amounts, see e.g. copending claim 1. The compositions may be used in keratin fiber dyeing processes as claimed, and may be packaged in multi-compartment kits as instantly claimed, see e.g. copending claims 27 and 32. The oxidation bases in the copending application may be p-aminophenol oxidation bases as claimed, see copending claims 11-12. The instantly claimed compositions, processes and kits are therefore obvious over the claims of the copending application, absent a showing otherwise.

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

Comparative Examples

The Comparative Examples are not deemed persuasive to overcome the above rejections for the reasons of record.

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Response to Arguments and Amendments

Applicant's Amendments are deemed persuasive to overcome the 35 U.S.C. 112, second paragraph, rejection previously of record.

Applicant's Remarks regarding the 35 USC 103(a) rejection over Lim '584 (Lim 1) in view of Akram have been fully considered, but are not deemed persuasive to overcome the rejection of record for the following reasons. Applicant argues that the combination does not teach or suggest compositions which use an oxidation base other than those excluded by the claims. Examiner respectfully disagrees because Lim '584's required 1-(5-amino-hydroxyphenyl)ethane-1,2-diol oxidation base is never excluded from the claims. In fact, this compound falls within the scope of those of formula (I) as claimed. Applicant further argues that all of Lim '584's relied upon Examples contain N,N-bis-(2-hydroxyethyl)-p-phenylenediamine, a coupler specifically excluded by claim 1. Examiner respectfully disagrees with this argument for two reasons. First, Lim '584's N,N-bis-(2-hydroxyethyl)-p-phenylenediamine is an oxidation base, not a coupler. Second, this oxidation base is never excluded from the claimed compositions. Note that Lim '584's N,N-bis-(2-hydroxyethyl)-p-phenylenediamine is different from the excluded 2-beta-hydroxyethyl-p-phenylenediamine. For all these reasons and the reasons of record, the rejection over Lim '584 in view of Akram remains.

Applicant's Remarks regarding the 35 USC 103(a) rejection over Lim '438 (Lim 2) in view of Akram have been fully considered, but are not deemed persuasive to overcome the above rejection for the following reasons. Applicant argues that the 2-chloro-4-aminophenol relied upon

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does not fall within the scope of the p-aminophenols of formula (I) as claimed. Upon reconsideration of Lim '438 and the claims, Examiner agrees with this argument. Lim '438, however, teaches that other p-aminophenol oxidation bases as claimed may be used in the patentee's compositions, see above rejection and the rejection of record. Furthermore, Lim's required 2-chloro-4-aminophenol differs from the claimed oxidation bases only in that it contains a chloro group rather than a fluoro group. Because Lim '438's oxidation base is used for the same purpose as the claimed compounds of formula (I), those skilled in the art would expect substantially equivalent dyeing results from such structurally related oxidation bases.

Applicant argues that although Akram teaches the claimed coupler, the patentee does not teach the claimed oxidation bases. This argument is not deemed persuasive because Akram is not relied upon as teaching the claimed oxidation bases. Instead, the patentee is relied upon as providing the motivation to select the claimed first coupler for use in Lim '438's compositions. For all these reasons, the above rejection remains.

Examiner acknowledges Applicant's Remarks regarding the above obviousness-type double patenting rejections.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caroline Liott whose telephone number is (703) 305-3703. The examiner can normally be reached on Mondays-Thursdays from 8:30am to 6:00pm, and on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached at (703)308-4708. All before final official faxes should be sent to (703) 305-7718. All after final official faxes should be sent to (703) 305-3599. All non-official faxes should be sent to (703) 305-6078.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0661.

C.D.L.
December 21, 2000


CAROLINE D. LIOTT
PRIMARY EXAMINER